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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,278	10/20/2005	Hiroataka Nishizawa	XA-10438	3115

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EXAMINER

SALERNO, SARAH KATE

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2814

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,278	Applicant(s) NISHIZAWA ET AL.	
	Examiner SARAH K. SALERNO	Art Unit 2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/20/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 8 is/are rejected.
- 7) ☒ Claim(s) 2,3,6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/23/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-2, 4-6 & 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 8, 12-13 & 16 of copending Application No. 10/550578. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims mentioned above in Application No. 10/550578 contain all of the limitations of claims 1-2, 4-6 & 8 of the instant application.

Specifically, regarding claim 1 of the instant application, claim 1 of the copending application discloses a semiconductor device which comprises external interface terminals and processing circuits, and which is fed with an operating power source

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when detachably set in a host equipment, wherein (claim 1 lines 1-4): said external interface terminals include power source feeding terminals, an extraction detecting terminal, and other terminals (Claim 1 lines 5-7); said power source feeding terminals are long enough to keep touching corresponding terminals of the host equipment for, at least, a predetermined time period since separation of said extraction detecting terminal from a corresponding terminal of the host equipment (claim 1 lines 8-12); and said power source feeding terminals are formed to be longer in an extraction direction than said extraction detecting terminal (Claim 1 lines 13-15).

Claim 2 of the instant application reads on claim 5 of Application No. 10/550,578

Claim 4 of the instant application reads on claim 8, lines 1-13, of Application No. 10/550,578.

Claim 5 of the instant application reads on claim 12 of Application No. 10/550,578

Claim 6 of the instant application reads on claim 13 of Application No. 10/550,578

Claim 8 of the instant application reads on claim 16, lines 1-10, of Application No. 10/550,578.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-2, 4-6 & 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-4, & 6-8 of U.S. Patent No.

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7,360,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims mentioned above in US Patent 7,360,713 contain all of the limitations of claims 1-2, 4-6 & 8 of the instant application.

Specifically, regarding claim 1 of the instant application, claim 1 of the copending application discloses a semiconductor device which comprises external interface terminals and processing circuits, and which is fed with an operating power source when detachably set in a host equipment, wherein (claim 1 lines 1-4): said external interface terminals include power source feeding terminals, an extraction detecting terminal, and other terminals (Claim 1 lines 5-7); said power source feeding terminals are long enough to keep touching corresponding terminals of the host equipment for, at least, a predetermined time period since separation of said extraction detecting terminal from a corresponding terminal of the host equipment (claim 1 lines 8-12); and said power source feeding terminals are formed to be longer in an extraction direction than said extraction detecting terminal (Claim 1 lines 13-15).

Claim 2 of the instant application reads on claim 3 of US Patent 7,360,713.

Claim 4 of the instant application reads on claim 4, lines 1-13, of US Patent 7,360,713.

Claim 5 of the instant application reads on claim 6 of US Patent 7,360,713.

Claim 6 of the instant application reads on claim 7 of US Patent 7,360,713.

Claim 8 of the instant application reads on claim 8, lines 1-10, of US Patent 7,360,713.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-3 & 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-3 & 6-7 are rejected for containing the flaws of their parent claims 1 & 4 which have been rejected under 35 U.S.C. 102.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (JP H03-187169)

Claim 1: Suzuki teaches a semiconductor device which comprises external interface terminals and processing circuits, and which is fed with an operating power source when detachably set in a host equipment, wherein: said external interface terminals include power source feeding terminals, an extraction detecting terminal, and

other terminals; said power source feeding terminals are long enough to keep touching corresponding terminals of the host equipment for, at least, a predetermined time period since separation of said extraction detecting terminal from a corresponding terminal of the host equipment; and said power source feeding terminals are formed to be longer in an extraction direction than said extraction detecting terminal (Abstract).

Claim 4: A semiconductor device which comprises external interface terminals and processing circuits, and which is fed with an operating power source when detachably set in a host equipment, wherein: said external interface terminals include power source feeding terminals, an extraction detecting terminal, and other terminals; and said power source feeding terminals are long enough to touch corresponding terminals of the host equipment for, at least, 1.0 millisecond since separation of said extraction detecting terminal from a corresponding terminal of the host equipment, with respect to an extraction speed of 2.5 meters/second (Abstract).

Claim 5: Suzuki teaches a semiconductor device according to claim 4, wherein said power source feeding terminals are formed to be longer in an extraction direction than said extraction detecting terminal (Abstract).

9. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Nishizawa et al. (US PGPub 2001/0009505)

Claim 8: Nishizawa teaches a semiconductor device which comprises external interface terminals and processing circuits, and which is fed with an operating power source when detachably set in a host equipment, wherein: said external interface

terminals are arranged in two rows in a direction crossing an extraction direction, and they include power source feeding terminals, an extraction detecting terminal, and other terminals; and said power source feeding terminals are long so as to extend from the first row over to the second row (FIG. 3a, [0107]).

Allowable Subject Matter

10. Claims 2-3 & 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2& 6 are allowable over the prior art because the prior art does not show power source feeding terminals made longer in both the extraction direction and the direction opposite the extraction direction than the extraction detecting terminal, the length of the power source feeding terminal protruding on the opposite side to the extraction direction, beyond said extraction detecting terminal being smaller in length than the length of the power source feeding terminal protruding on the extraction direction.

Claims 3 & 7 are allowable over the prior art because the prior art does not teach power source feeding terminals touches the corresponding terminal of the host equipment at two points along the extraction direction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH K. SALERNO whose telephone number is (571)270-1266. The examiner can normally be reached on M-F 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K. S./
Examiner, Art Unit 2814

/Theresa T. Doan/
Primary Examiner, Art Unit 2814